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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,253	10/31/2000	Marrie Harras	LEX-0081-USA	1776

7590 12/18/2002

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EXAMINER

LANDSMAN, ROBERT S

ART UNIT	PAPER NUMBER
1647	

DATE MAILED: 12/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/703,253	HARRAS ET AL.
	Examiner Robert Landsman	Art Unit 1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 November 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 5-7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Formal Matters

A. Amendment B, filed 11/20/02, has been entered into the record. Claims 1-4 were pending in the application. Claims 1-2 were the subject of the previous Office Action, dated 7/9/02. In Amendment B, Applicants cancelled claims 3-4 and added new claims 5-7. Therefore, claims 1 and 5-7 are pending and are the subject of this Office Action.

B. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Objections

A. All objections to the claims, title and abstract have been withdrawn in view of Applicants' amendments.

3. Claim Rejections - 35 USC § 101

A. Claims 1 and 5-7 remain rejected under 35 USC 101 for the reasons already of record on pages 3-5 of the Office Action dated 7/9/02. First, the Examiner accepts the apology of Applicants' representative, but at no time was the Examiner concerned that Applicants' representative intended to mislead the Examiner. Applicants argue that the Action of Paper No. 14 appears to recognize that the protein of the present invention is a splice variant of ABCC11. However, this conclusion does not appear to have been drawn in that Office Action. Applicants argue that Tammur et al. recognize the value and utility of ABCC11 and ABCC12 and their association with paroxysmal kinesigenic choreoathetosis and infantile convulsions with paroxysmal choreoathetosis, which are human inherited diseases. Tammur et al. also teach that ABCC11 and ABCC12 could share functional similarities with ABCC4 and ABCC5, including transporting organic anions, nucleotide analogs and cyclic nucleotides. Finally, Applicants argue that Yabuuchi et al. support Applicants assertion that the present invention is a splice variant of ABCC11. These arguments have been considered, but are not deemed persuasive.

First, the Examiner cannot find any passage of Yabuuchi et al. stating that SEQ ID NO:23 of the present invention is an ABCC11 splice variant, nor has any evidence been provided in either Tammur et al. or Yabuuchi et al. demonstrating the function of the protein encoded for by SEQ ID NO:23 of the

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present invention. Even if the protein of the present invention was a variant of ABCC11, the fact that approximately 160 amino acids of the protein of Tammur et al. and Yabuuchi et al. are missing in the protein encoded for by SEQ ID NO:23 of the present invention (out of approximately 1380 amino acids) would lead the artisan to believe that the protein of the present invention had different properties than those of the prior art. It is not known from simply examining the nucleotide sequence of SEQ ID NO:23 that the encoded protein would be involved in the same human inherited diseases as ABCC11 and ABCC12, or that this protein would transport the same anions and nucleotides. Therefore, speculation as to the function of the protein of the present invention by Tammur et al. and Yabuuchi et al. cannot be used to demonstrate its utility.

4. Claim Rejections - 35 USC § 112, first paragraph - enablement

A. Claims 1 and 5-7 remain rejected under 35 USC 112 for the reasons already of record on page 6 of the Office Action dated 7/9/02 as well as for the reasons given in the above rejection under 35 USC 101. Applicants argue that the claimed invention is enabled because it has utility as argued previously. Applicants' arguments have been fully considered, but are not found to be persuasive for the reasons discussed above.

B. The rejection of claim 1 under 35 USC 112, first paragraph, regarding "hybridization" and "24 contiguous bases" has been withdrawn in view of Applicants' cancellation of these phrases.

5. Claim Rejections - 35 USC § 112, second paragraph

A. All rejections under 35 USC 112, second paragraph, have been withdrawn in view of Applicants' amendments to the claims to cancel the rejected subject matter.

6. Claim Rejections - 35 USC § 102

A. All rejections under 35 USC 102 have been withdrawn in view of Applicants' amendments to the claims to remove "at least 24 contiguous bases."

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
December 13, 2002



GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600